

REMARKS

In the non-final office action mailed on November 17, 2006, claims 1-72 were pending. Claims 5-8 and 30-72 were withdrawn from consideration, and claims 1-4 and 9-29 stand rejected. In this response, claims 30-72 have been cancelled without prejudice to pursuit in a divisional application. Claims 1 and 19 have been amended, and claims 73-90 have been added. Reconsideration of the present application as amended is respectfully requested.

Claims 19-29 were rejected under 35 USC §112, second paragraph since "said body" lacked antecedent basis. Claim 19 has been amended in a non-limiting manner to recite "said guide member" instead of said body. Withdrawal of this basis of the rejection of claims 19-29 is respectfully requested.

Claims 1-4, 9, 10 and 15-18 were rejected under 35 USC §102(e) by U.S. Patent Application Publication No. 2004/0020254 to Cook et al. Claim 1 has been amended to correct a typographical error in line 6 and to clarify the arrangement between the distal portion and the guide member of the guide instrument. With respect to claim 1, the Office Action asserts that Cook discloses "a guide instrument including a guide member (page 3, paragraph 1)." However, it is respectfully submitted that Cook fails to disclose a "guide instrument" arranged as recited in claim 1. "[A]n invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co. Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

A review of Cook finds that it discloses "[a] hollow single or double lumen sleeve may then be placed in operative contact with plate 2 using the plate 2 as a guide for the hollow sleeve to guide in drilling holes for implant cages between the vertebrae. A spinal fixation implant is then placed through the hollow sleeve and into intervertebral space V." The "guide instrument" in Cook is a sleeve that guides a drill between the vertebrae so that a cage can be implanted between the vertebrae after the plate 2 is already implanted. There is no disclosure of any structure adapted to guide an instrument for forming a hole to receive bone screw 5. Nor is there any disclosure of an instrument that is also adapted to guide a cutting instrument to form a recess in tissue between the hole that receives bone screw 5 and opening into the space between the vertebrae while the distal portion of the instrument is in the defect. Claim 1, in contrast, recites

"a guide instrument including a distal portion positionable in the defect, said guide instrument including a guide member adapted to guide an instrument for forming a hole in the tissue to receive the at least one anchor, said guide member being further adapted to guide a cutting instrument for forming a recess in the tissue extending between the hole and the defect while said distal portion is positioned in the defect." Therefore, Cook cannot anticipate claim 1 and withdrawal of this basis of the rejection is respectfully requested.

Claims 2-4, 9, 10 and 15-18 depending from claim 1 were also rejected as being anticipated by Cook. These claims are patentable at least for the reasons claim 1 is patentable, and withdrawal of the rejection of these claims is respectfully requested.

Claims 11-14 were rejected under 35 USC §103(a) as being unpatentable over Cook et al. The Examiner asserts it would have been an obvious matter of design choice to modify the Cook device to be made from the claimed non-resorbable materials or resorbable materials since "it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice." However, in order to modify a reference to support an obviousness rejection, there must be some teaching or suggestion of the desirability of the proposed modification. Where the reference teaches away from the modification, or the modified device would not be suitable for its intended purpose, the modification is not obvious. Cook teaches an implant that provides an elastic support structure formed by the elastic elements so that "during loading, the support members are elastically deformed, and the compressive forces acting in the direction of the member axis are converted into edges stresses in the annulus fibrosus." The use of materials which do not provide an elastic support structure runs counter to the teaching of Cook. The Examiner has not provided any reference that teaches or suggests the desirability of the modification to Cook as proposed by the Examiner. Rather, it appears that the Examiner has used the teachings in Applicant's specification in the present application to modify Cook. However, the present application is not a proper reference that can be employed to modify Cook to support an obviousness rejection. If the teaching in Applicant's own specification has not been relied upon, then citation of a reference that teaches or suggests the desirability of modifying Cook to teach or suggest claims 11-14 is respectfully requested. Alternatively, if the rejection is based on facts within the

personal knowledge of the Examiner, then an affidavit providing the same is requested so the rejection can be considered and traversed if appropriate.

Claims 19-24 and 26-29 stand rejected under 35 USC §103(a) as being unpatentable over Cook et al. in view of U.S. Patent Application Publication No. 2006/0074425 to Sutterlin et al. Sutterlin discloses a device for removing body tissue with a brush member 12 and a cannula assembly 14. The cannula assembly includes a cannula member 16 with an inner lumen 20 dimension to pass the brush member therethrough. Sutterlin discloses that “[i]mportantly, the distal end of the cannula member 16 (opposite the handle member 18) serves to form a protective barrier between the brush member 12 and tissue adjacent the surgical target site...” Accordingly, the device in Sutterlin is arranged to prevent any exposure of the cutting instrument within the cannula to tissue along the cannula, and only when the cutting instrument is passed through the distal end opening of the cannula is it operable to remove tissue. As discussed above, Cook fails to disclose the guide instrument arranged as recited in claim 1. Sutterlin also fails to disclose the guide instrument in claim 1, nor does it teach or suggest modifying the sleeve disclosed in Cook et al. to arrive at the guide instrument of claim 1. Therefore, proposed combination of Cook and Sutterlin fails to teach or suggest all the elements in claim 1, and therefore cannot teach or suggest all the elements in claims 19-24 and 26-29 depending from claim 1. Withdrawal of this basis of the rejection is respectfully requested.

Furthermore, neither Cook nor Sutterlin disclose or suggest several features recited in claims 19-24 and 26-29. For example, claim 20 recites “wherein said guide instrument member further comprises a positioning flange extending distally from said guide member and offset from said passage.” There is no structure corresponding to the positioning flange extending distally from the body since lip 22 only extends outwardly from the cannula of Sutterlin. Claim 21 depends from claim 20 and recites “wherein said positioning flange comprises a portion of a positioning member, said positioning member including a body mounted to said guide member, said positioning flange extending distally from said body.” This arrangement including the positioning member with the body and the flange arranged as recited is not disclosed or suggested in Sutterlin. Claim 22 depends from claim 20 and recites “wherein said body includes a slot therethrough aligned with and in communication with said slot of said guide member.” Sutterlin also fails to disclose or suggest any slot extending through a body of a positioning

member mounted to the guide member. Claim 28 recites "wherein said cutting instrument includes an elongated shaft positionable in said passage, said cutting instrument further comprising a blade extending from said shaft through said slot and movable along said slot with movement of said shaft along said passage." As discussed above, the brush in Sutterlin is maintained within the cannula, and does not extend from any slot as it moves along the cannula. Accordingly, withdrawal of this basis of the rejection of claims 19-24 and 26-29 depending from claim 1 is respectfully requested.

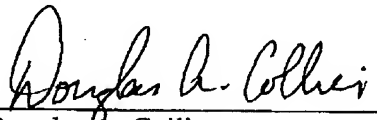
Claims 73-90 have been added in this response and recite features not disclosed or suggested in the cited references. For example, claim 73 recites at least one blocking member, at least one anchor and a guide instrument that includes "a guide member adapted to guide an instrument for forming a hole in the tissue to receive the at least one anchor, said guide member being elongated and includes a passage extending therethrough and opening at a distal end thereof for receiving and guiding the instrument for forming the hole, said guide member further including a slot extending through said distal end thereof in communication with said passage, said slot for receiving and guiding a cutting instrument for forming a recess in the tissue between the hole and the defect." These features are not disclosed or suggested in the cited references, and claim 73 is allowable. Claims 74-85 depend directly or indirectly from claim 73 and are also allowable.

Claim 86 recites at least one blocking member, at least one anchor, and a guide instrument that includes "a distal portion positionable in the defect, said guide instrument including a guide member adapted to guide an instrument for forming a hole in the tissue to receive the at least one anchor, said guide member being further adapted to guide a cutting instrument for forming a recess in the tissue extending between the hole and the defect, wherein said guide member includes a shaft extending proximally from said guide member and a handle assembly extending from said shaft, said handle assembly including a handle member oriented transversely to a longitudinal axis of said guide instrument, wherein said handle member is securable at a plurality of locations along said shaft to adjust a length of said guide instrument extending distally from said handle member." These features are not disclosed or suggested in the cited references, and claim 86 is allowable. Claims 87-90 depend directly or indirectly from claim 86 and are also allowable.

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In view of the foregoing amendments and remarks, claims 1-29 and 73-90 are in condition for allowance, and a Notice of Allowance is hereby solicited. The undersigned would welcome an interview with the Examiner to resolve any outstanding issues with regard to the present application

Respectfully submitted,

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